

Oliver Nickel  
USSN 09/844,084

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, the Examiner made a comment regarding the abstract at page 2 of the Office Action. Applicant submits there is no defect in the abstract.

Claims 1- 18 are pending. Amendments have been made to claims 2-8 and 10 and new claims 11-18 have been added in response to the Examiner's rejections under 35 U.S.C. 112, second paragraph. The mark-up showing the changes that have been made to the previous claims using brackets and underlining and also showing the new claims is attached. It is believed that no new matter has been added.

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Rejections under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 1-8 and 10 under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner found the term "is capable" of being indefinite, but does not give any particular reason why its use renders the claims containing it indefinite. In response, Applicant points out functional language "does not, in and of itself, render a claim improper", and the language must be evaluated as to what it conveys to a person of ordinary skill in the art. *See MPEP 2173.05(g)*. Moreover, Applicant respectfully disagrees that it is not a limitation since materials incapable of performing the stated function are thereby excluded. Also, Applicant submits the term is an art-recognized term, wherein a search of the USPTO website database on March 18, 2003 revealed some 176,000 patents, including 4 patents directed to tapes, where the term 'is capable' is found in the claims. Clearly, the term is commonly used in a variety of different arts, and has enjoyed widespread acceptance by the Patent Office itself.

With respect to the Examiner's other concerns, Applicant has amended the claims in a manner which Applicant believes clearly overcomes the Examiner's concerns. In claim 2, Applicant has canceled the term "so-called." The preferred clauses, for example, those including "especially," "in particular" and "particularly," have been made the subject of separate dependent claims. And, in claim 4, the term "good" has been deleted.

For the record, Applicant emphasizes that although the claims were amended to overcome this

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rejection, and, therefore, might be considered to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicant did not narrow the claims in any material respect. Therefore, Applicant submits that the amended claims are entitled to the full range of equivalents.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

#### Rejections under 35 U.S.C. 103

Claims 1-10 were rejected under 35 U.S.C. 103(a) as being obvious over Leewenburgh (U.S. Patent No. 5,935,669) in view of Akimoto et al. (U.S. Patent No. 4,358,494). According to the Examiner, Leewenburgh teaches a cover sheet for protection of paint splatter which comprises an adhesive tape and a plastics material sheet. However, the Examiner found the reference fails to teach adhering a masking material having a material covering sheet to the adhesive tape. The Examiner found Akimoto to teach a paper-backed pressure-sensitive adhesive tape comprising a sheet of bleached or unbleached kraft paper, a widthwise stretched high-density polyethylene film, an adhesive layer to lap seal the film onto the backing layer, a polyethylene release layer over the film, and a pressure sensitive adhesive layer over the kraft paper layer. The Examiner also found the heat-resistant limitations in claims 1 and 2 to be inherent in the

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adhesive tape of Leewenburgh. The Examiner ultimately found it would have been obvious to longitudinally adhere the adhesive tape of Akimoto to the adhesive tape material of Leewenburgh.

In response, Applicant would remind the Examiner combined references must teach or suggest all the claim limitations. See *MPEP* §2143. Applicant submits a combination of the references would not have led a person having ordinary skill in the art to the present invention, because there is no suggestion or motivation for a masking material to be laminated in the same *edge region* of the adhesive composition and for the masking sheet to cover the masking material "*on a side thereof*". Applicant points out the masking material taught in Akimoto and as alleged by the Examiner, is not analogous to the masking material as claimed. Rather, Applicant submits the masking material or "backing paper" of Akimoto is more analogous to a paper backing of an adhesive tape, because Akimoto refers to the backing paper as those used in paper-backed adhesive tapes. See col. 3, lines 54-59. Thus, Akimoto fails to teach or suggest an analog to the claimed masking material, wherein the masking material is laminated on an edge region of the pressure sensitive adhesive composition and is covered by the masking sheet. Accordingly, the claims would not have been rendered *prima facie* obvious by a combination of the references.

Regarding the inherency of the heat-resistant limitations, Applicant submits that the Examiner has not established a *prima facie* case of inherency. As pointed out by the Board of Patent Appeals and Interferences in *Ex parte Levy*, 17 USPQ2d 1461, 1463-1464 (BPAI 1990):

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"[T]he initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the Examiner. \* \* \* In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. [Emphasis in original.]"

Applicant points out the Examiner has only referred to the adhesive tape as creped and has not shown that a creped tape *necessarily* to be extensible, flexible, and have a thickness of 100 to 250  $\mu\text{m}$  as claimed in those claims including these limitations. Accordingly, Applicants submit that the Examiner has not discharged this initial burden to make out a *prima facie* case of inherency as to these particular limitations.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

#### Conclusion

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However,

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should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR §1.111 and the attached Amendment to the Claims (11 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: March 19, 2003

By David D. Kim  
David D. Kim

GROUP 1700  
MAR 20 2003  
FAX RECEIVED